REMARKS/ARGUMENTS

Claims 13, 16-17, and 19-27 are pending in this application, with claim 13 being the only independent claim. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Drawing Objections

The Examiner has objected to the drawings as not showing the spring or electric attraction magnet motors recited in claims 13 and 27 and the rotary motor including a spring force as recited in claim 26. Applicant has added Fig. 3 to show a linear motor which may comprise a spring or electric attraction magnet as described at page 3, lines 16-18 of the specification as originally filed. Applicant has also added Fig. 4 to show a rotary motor based on a spring force which is described at page 3, lines 21-22 of the specification as originally filed. The specification is amended to reference new Figs. 3-4. Since the subject matter shown in new Figs. 3-4 was described in the specification as originally filed, now new matter is added. In view of the new drawings, the objection to the drawings should now be withdrawn.

Objections to the Claims

The claims are objected to because of editorial errors noted by the Examiner. The claims are amended in accordance with the Examiner's suggestions. Accordingly, the objections should now be withdrawn.

Rejection of Claims under 35 U.S.C. §112, first paragraph

Claims 13, 16-17, and 19-27 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Regarding enablement, the CCPA has held that the "specification need describe the invention only in such detail as to enable a person skilled in the most relevant art to make and use it". *In re Naquin*, 398 F. 2d 863, 158 USPQ 317 (CCPA 1968)

(see also MPEP §2164.05(b)). Furthermore, the specification need not describe or enable the invention to a layperson. *General Elec. Co. v. Brenner*, 407 F.2d 1258, 159 USPQ 335, 337 (D.C. Cir. 1968). *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.* shows that enablement is possible when an application lacks specific disclosure of hydraulic and electrical control systems. The invention in *Lindemann* related to a scrap shear used to cut scrap metal into smaller pieces and contained no description of the hydraulic and electrical control systems. Those skilled in the art could build the device without undue experimentation. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F. 2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Furthermore, *In re Howarth*, 654 F.2d 103, 210 USPQ 689 (CCPA 1981), illustrates that enablement may be satisfied using information found in prior art.

Against this legal background, applicant traverses the Examiner's allegation that the specification fails to provide adequate enablement for a person skilled in the art to make and use the invention. The person skilled in the art for the present application is one who designs and/or maintains the printing units. Thus, the person skilled in the art for the subject matter of the present application is a technician or engineer.

The Examiner alleges nonenablement because it is not clear to the Examiner from the disclosure how a spring, an electric attraction magnet, or a rotary motor can be used to provide adjustability. The specific types of motors to be used are specified in the application. Applicant notes that a technician or engineer is aware of the fundamental knowledge that a linear spring force is changed by varying the tension on a spring and electric attraction force is varied by varying current through the coil generating the magnetic force. Likewise, the rotary motor based on electricity or spring force can be varied similarly. Since the adjustability of a force generated by a

spring or electric motor is known to the person skilled in the art, the specification enable one skilled in the art to provide an adjustable force using one of the disclosed motors.

The Examiner further alleges that it is not clear how the motors are attached to the structures (levers). That is, the Examiner alleges that the connection between the output of the motor and the lever is not shown. In general, mechanisms for translating a rotary output of a rotary motor to a pivoting motion of the lever and for translating a linear output of a linear motor to a pivoting motion of the lever are known to those skilled in the art. Furthermore, the drawings as originally filed show that the linear motion of a pneumatic linear motor 9, 10 pushes or pulls the levers 7, 8 and the rotary motor acts on the pivoting axis of the levers 7, 8. Such mechanical connections are known to a mechanical technician or engineer. Thus, a person skilled in the art is enabled to connect a rotary motor or a linear motor to the pivot levers 7, 8 based on the disclosure of the application.

The Examiner further indicates that it is not known how the motor of claim 26, i.e., a spring motor, operates. A spring motor is known in the mechanical arts. See, for example, U.S. Patent No. 3,194,343 (Sindlinger). As mentioned above, *In re Howarth* illustrates that enablement may be satisfied using information found in the prior art. In view of Sindlinger, one skilled in the mechanical arts is enabled to use a spring motor for pivoting a lever.

The Examiner states that it is not clear how adjustability is automatic. As described above, the adjustment itself is known. Furthermore, the specification states that the contact force can be selected by varying the throwing-on force (page 1, lines 30-34 of the specification as originally filed). Since the throwing-on force is maintained by the motor, the adjustment of the contact force is automatic in response to swelling or shrinking of the applicator roll (see page 1, line

34 to page 2, line 8 of the application as originally filed). This disclosure enables persons skilled in the art to make an use an automatically adjustable throw-on force.

The Examiner also questions how the lock mechanisms 14, 15 lock the applicator roll in the thrown-on position. Fig. 1 shows the locking apparatus 14 as a device that clamps onto the piston rod 13, thereby locking the piston rod at a specific location. The locking apparatus 15 similarly works between the lever and the journal on which the lever pivots. This disclosure enables the person skilled in the art to make and use the claimed locking mechanism.

In view of the above remarks, the specification is deemed to provide proper enablement to one of ordinary skill in the art related to designing or putting together inking or dampening units in a rotary printing machine.

Allowability of the Claims

The present invention solves a problem associated with setting and adjusting applicator rolls. None of the prior art of record has solved the problem using the motors recited in the claims. Therefore, the application is deemed to be in condition for allowance and notice to that effect is solicited.

Conclusion

The application is now deemed to be in condition for allowance and notice to that effect is solicited.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By 

Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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